

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: PAY DIRT: TREASURES OF CHICHEN ITZA
Application Serial No: 85654918
Classes: 009, 035, 041
Applicant: Hoserland Productions Inc.
Our Reference: 630T1
Examining Attorney: Esther A. Belenker
Law Office: 111

RESPONSE TO OFFICE ACTION AND AMENDMENT TO APPLICATION

This is the Applicant's response to the Office Action dated September 30, 2012 (the "Office Action"). In the Office Action, the Examining Attorney indicated that registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3786018. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* In the Office Action, the Examining Attorney also indicated that the Applicant should request suspension of this U.S. application until a copy of the foreign registration is available, amend the application to correct informalities, and satisfy the multiple class requirements for sections 1(b) and 44 by March 30, 2013.

Confusion

In the Office Action, the Examining Attorney indicated that registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3786018 (the "Cited Registration"), which appears to be registered to Gateway Gaming LLC ("GGLLC").

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01.

In the Office Action, the Examining Attorney stated that any one factor may be dominant in a given case, depending upon the evidence of record and that in the present case, the similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services are the most relevant factors.

In the present case, the Cited Registration and the applied-for-mark, the goods and/or services identified in the Cited Registration and in the applied-for-mark, and the trade channels of the goods and/or services identified in the Cited Registration and in the applied-for-mark are all dissimilar.

First, the Cited Registration and the applied-for-mark are dissimilar because Cited Registration is only for the word “PAYDIRT” whereas the Applicant’s applied-for-mark includes the entire phrase “PAY DIRT: TREASURES OF CHICHEN ITZA”, the differences being use of the term “PAY DIRT” as two separate, disjunctive words and the presence of the additional wording “TREASURES OF CHICHEN ITZA”.

Second, the goods and services in the applied-for-mark are completely dissimilar than the goods and services in the Cited Registration.

The goods and services identified in the Cited Registration include:

Class 9: Gaming equipment, namely, gaming machines

The term “gaming” is defined as:

1. gambling.
2. the playing of games developed to teach something or to help solve a problem, as in a military or business situation.
3. the playing of computer or video games.

See Dictionary.com, "Gaming," in *Dictionary.com Unabridged*. Source location: Random House, Inc. <http://dictionary.reference.com/browse/Gaming>. Available: <http://dictionary.reference.com>. Accessed: March 21, 2013.

In the present case, the specimen of use submitted during prosecution of the Cited Registration on January 28, 2010 appears to be a photograph of a slot machine used for gambling purposes. Slot machines are machines used for gambling purposes in, for example, casinos. Therefore, the term “gaming” in the Cited Registration clearly refers to “gambling” only.

In contrast, the Applicant’s applied-for-mark is directed to the following goods and services:

Class 9: video games for mobile devices, personal computers, consoles, tablets; electronic game programs; downloadable electronic game programs; electronic game software; computer game programs; downloadable computer game programs; interactive game programs; interactive game software; compact discs, storage media containing computer games

Class 35: promoting the sale of goods and services of others through promotional contests

Class 41: entertainment services, namely providing a web site featuring entertainment information in the fields of electronic programs; providing access to downloadable game application via the Internet

The terms “game” and “games” in Cited Registration refer to “computer or video games” not gambling or slot machines. Therefore, the “gambling” goods in the Cited Registration are completely different than the video or computer “games” for mobile devices identified in the applied-for-mark, which are not used for gambling purposes or with slot machines.

Third, the trade channels of the goods and/or services identified in the Cited Registration and in the applied-for-mark are all dissimilar because the gaming equipment, namely, slot machines, are generally sold to industry casinos, bars, and restaurants, whereas video games for mobile devices, such as cell phones, are generally sold directly to individual consumers, as, for example, mobile computer software applications that are downloadable via the Internet.

Furthermore, in response to this objection, the Applicant has amended the identification of the goods and services in the applied-for-mark to include language specifying that the goods are “not for use in gaming in the nature of gambling and slot machines” and that the services are “not in relation to gaming in the nature of gambling and slot machines”, in order to clarify that the goods and services of the applied-for -mark do not relate to “gambling” or “slot machines”.

For these reasons, the Applicant respectfully submits that the applied-for-mark does not create confusion with the Cited Registration and respectfully requests withdrawal of this objection to registration.

Dual Bases

In the Office Action, the Examining Attorney states that the present application specifies both an intent to use basis under Trademark Act Section 1(b) and a claim of priority under Section 44(d) based on a foreign application, that no copy of a foreign registration has been provided even though the application indicates applicant’s intent to rely on Section 44(e) as an additional basis for registration, and that the Applicant must provide a copy of the foreign registration from applicant’s country of origin when it becomes available.

The Applicant submits that it has not yet provided a copy of the Canadian PAY DIRT: TREASURES OF CHICHEN ITZA registration because this foreign trademark application is currently pending. The Applicant cannot provide a copy of this foreign registration until it is registered. Since the foreign registration has not yet issued, the Applicant respectfully requests suspension of this U.S. application until a copy of the foreign registration is available.

Identification of Goods and Services

The Office Action states that the identification of the goods and/or services is unacceptable and must be clarified because some of the wording is indefinite and/or misclassified.

1. Identification of Goods – International Class 9

The Office Action states that:

the wording “video games for mobile devices,” “compact discs, storage media containing computer games” in the identification of goods is indefinite and must be clarified because the nature of “video games” is unclear. Also, the compact discs must be identified as blank or pre-recorded, and if prerecorded, the subject matter must be listed, and the nature of the storage media must be indicated, and whether it is blank or pre-recorded, and if pre-recorded, the subject matter must be listed. *See* TMEP §1402.01. Applicant must amend the identification to specify the common commercial name of the goods. If there is no common commercial name, applicant must describe the product and its intended uses. *See id.* Applicant may adopt one or more of the following, if accurate

Video game ____ (list, e.g., software, discs, cartridges, etc.) for mobile devices, personal computers, consoles, tablets; electronic game programs; downloadable electronic game programs; electronic game software; computer game programs; downloadable computer game programs; interactive game programs; interactive game software; compact discs featuring ____ (list, e.g., computer game software, etc.);, electronic storage media containing computer game software; downloadable electronic game programs; in Class 9.

In response, the Applicant has amended the identification of the goods in Class 9 by amending “video games” and “compact discs” to “video game[[s]] software” and “compact discs featuring computer game software”, respectively, in accordance with the Examining Attorney’s suggestion. The Applicant has also amended the identification of goods in Class 9 to clarify that these goods are not for use in gaming in the nature of gambling and slot machines, as discussed above.

2. Identification Of Services – International Class 35

The Office Action states that the wording in Class 35 is acceptable. Therefore, the Applicant has only amended the identification of services in Class 35 to clarify that these services are not in relation to gambling or slot machines, as discussed above.

3. Identification Of Services – International Class 41

The Office Action states that the wording “providing access to downloadable game application via the Internet” in the identification of services is misclassified, that services involving providing access to the Internet are in Class 38, while downloadable electronic game programs are appropriate for in Class 9, and providing online computer games is appropriate for Class 41. The Examining Attorney suggested substitution of one or both of the following, if accurate:

Providing access to online downloadable computer games on the Internet, in Class 38;

Entertainment services, namely providing a web site featuring entertainment information in the fields of electronic programs; providing online ____ (list, e.g., video, computer, electronic) games; in Class 41.

In response, the Applicant has amended the description of these services in Class 41 by moving the wording “providing access to online downloadable computer games on the Internet” from Class 41 to new Class 38 and by adding the wording “providing online electronic games, not in relation to gaming in the nature of gambling and slot machines” to Class 41, in accordance with the Examining Attorney’s suggestion. The Applicant has also amended the identification of services in Class 41 to clarify that these services are not in relation to gambling or slot machines, as discussed above.

The Applicant respectfully submits the following amendments to the applied-for-mark’s goods and services in international classes 9, 35, and 41 and new class 38 with additions shown with underlining and deletions shown with strikethrough:

International Class 9

video game[[s]] software for mobile devices, personal computers, consoles, tablets; electronic game programs; downloadable electronic game programs; electronic game software; computer game programs; downloadable computer game programs; interactive game programs; interactive game software; compact discs featuring computer game software; electronic storage media containing computer game[[s]] software; downloadable electronic game programs, not for use in gaming in the nature of gambling and slot machines

International Class 35

promoting the sale of goods and services of others through promotional contests, not in relation to gaming in the nature of gambling and slot machines

International Class 38

providing access to online downloadable computer games on the Internet, not in relation to gaming in the nature of gambling and slot machines

International Class 41

entertainment services, namely providing a web site featuring entertainment information in the fields of electronic programs, not in relation to gaming in the nature of gambling and slot machines; providing online electronic games, not in relation to gaming in the nature of gambling and slot machines ~~access to downloadable game application via the Internet~~

The Applicant submits that these amendments to the identification of goods and services clarify or limit the goods and services and do not add to or broaden the scope of the goods and services.

MULTIPLE CLASS REQUIREMENTS

The Applicant submits that these requirements have been satisfied.

CONCLUSION

The Applicant respectfully submits that the amendments to the goods and services address the informalities and requests allowance and registration of the mark PAY DIRT: TREASURES OF CHICHEN ITZA.

Dated: March 21, 2013

Respectfully submitted,

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